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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/529,432

03/25/2005

Kanji Tanaka

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05/14/2008

OKADA

C/O KEATING & BENNETT, LLP

8180 GREENSBORO DRIVE

SUITE 850

MCLEAN, VA 22102

EXAMINER

WILLIAMS, JAMILA O

ART UNIT

PAPER NUMBER

3725

NOTIFICATION DATE

DELIVERY MODE

05/14/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JKEATING@KBIPLAW.COM

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<b>Office Action Summary</b>	<b>Application No.</b> 10/529,432	<b>Applicant(s)</b> TANAKA ET AL.	
	<b>Examiner</b> JAMILA WILLIAMS	<b>Art Unit</b> 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-13 is/are rejected.
- 7) ☒ Claim(s) 14-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3-25-05</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,3 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim1 of copending Application No. 11/721299 in view of 6,276,862 to Snyder et al.

Claim 1 of ‘299 recites the binding rings, holding member, operating member including a pair of operating pieces, operating member having a surface to which base portions of the respective binding rings are secured, an opening/closing member which when the rings are opened moves the operating pieces within the holding member in a longitudinal direction of the holding member to an opening direction such that the

operating pieces are held in a direction approaching an inner surface of the holding member, which is recited in claim 1 of the present application.

Claim 3 of '299 recites portions of the binding rings are secured to one of the operating pieces and the other base portion of the binding rings is secured to the other operating piece and when the binding rings are closed the operating member is held in a state in which abutting edges of the operating pieces abut against each other at a position away from the inner surface of the holding member, which is recited in claim 1 of the present application.

'299 does not expressly recite the abutting edges are maintained at a location closer to the inner surface of the holding member when the rings are opened than the location of the abutting edges when the rings are closed.

Snyder et al teaches having operating pieces (14,16) fixed to the holding member (36) such that abutting edges are maintained in an abutting state at a location spaced from the inner surface of the holding member when the rings are closed (figure 6) and the abutting edges are maintained at a location closer to the inner surface of the holding member when the rings are open (figure 5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the teaching of Snyder et al with the binding device of '299 for the purpose of aiding in opening and closing the rings.

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Lucchesi (U.S. Patent 2,715,906).

Regarding claim 11, Lucchesi discloses a binder 1 comprising: binding rings 4b/5b; a holding member 19/20 having a length that allows said binding rings to be arranged at a distance from one another; an operating member 3 movably fixed inside the holding member such that respective bases 4c/5c of the binding rings 4b/5b are secured onto a surface of the operating member at a desired distance so as to secure the binding rings to the holding member (through contact with the operating member 3 which is coupled to the holding members 19/20); the operating member 3 including a pair of operating pieces 4/5 which move within the holding member in a longitudinal direction of the holding member (5 moves within the holding member in a longitudinal direction of the holding member- column 2 lines 55-60), the pair of operating pieces 4/5 are fixed to the holding member such that abutting edges thereof are maintained in an abutting state at a location spaced from an inner surface of the holding member when the binding rings are closed (the location spaced above the inner surface of cover or

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holding members 19/20 is the position of 4/5 in figure 1) and the abutting edges are maintained at a location closer to the inner surface of the holding member when the rings are opened than the location of the abutting edges when the binder rings are closed (the location closer to the inner surface of the holding member 19/20 is the position in figure 2) and an opening/closing member (spring 15 functions to as opening/closing member by urging operating piece 5 away from operating piece 4 longitudinally) arranged to shift the binding rings in an opening direction such that the operating pieces are moved in the longitudinal direction of the holding member within the holding member and are maintained at the location closer to the inner surface of the holding member when the rings are opened (figure 2)

Regarding claim 12, Lucchesi discloses the holding member 19/20 includes holding walls (vertical walls at the edge of 17) that extend in a direction that is substantially parallel to the longitudinal direction of the holding member and the operating member 3 includes outer edges that slide inside the holding walls (5 slides relative to 4 within the walls of 17).

Regarding claim 13, Lucchesi discloses the operating member 3 includes a pair of operating pieces 4/5 that slide within the holding member in the longitudinal direction of the holding member (5 slides relative to 4 within walls of 17 which is part of the holding member or binder cover), the pair of operating pieces include outer edges that slide in the longitudinal direction of the holding member and abutting edges that enable the pair of operating pieces to abut against each other on inner edges parallel to the

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outer edges (hinge elements 12,13,14 are part of the outer edges and 4a,5a are the inner edges that abut against each other as shown in figure 1).

***Allowable Subject Matter***

Claims 14-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMILA WILLIAMS whose telephone number is (571)272-4431. The examiner can normally be reached on Monday-Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. W./  
Examiner, Art Unit 3725

/Derris H Banks/  
Supervisory Patent Examiner, Art  
Unit 3725